

REMARKS

The Examiner is thanked for the due consideration given the application.

Claims 24-28 are pending in the application. Claims 1-23 have been canceled. Claims 24-28 are newly presented for consideration on the merits.

No new matter is believed to be added to the application by this amendment.

Rejections Based on ELLNER et al.

Claims 1-5, 9 and 10 have been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al. (U.S. Patent No. 6,618,328) in view of HAYAKAWA (EP 1096641). Claim 8 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al. (U.S. Patent No. 6,618,328) in view of HAYAKAWA, and further in view of SATO (U.S. Patent No. 6,657,922).

These rejections are respectfully traversed.

The present invention pertains to a watch case with a middle (7) and a back that is typically illustrated, by way of example, in Figure 6 of the application, which is reproduced below.

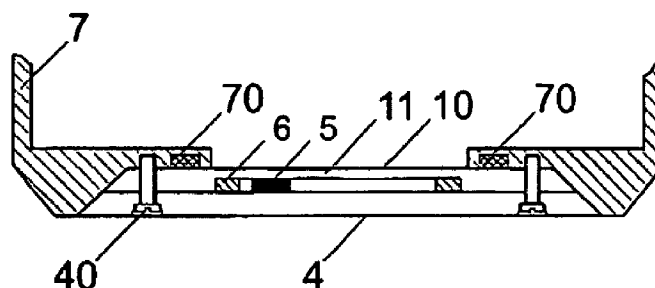
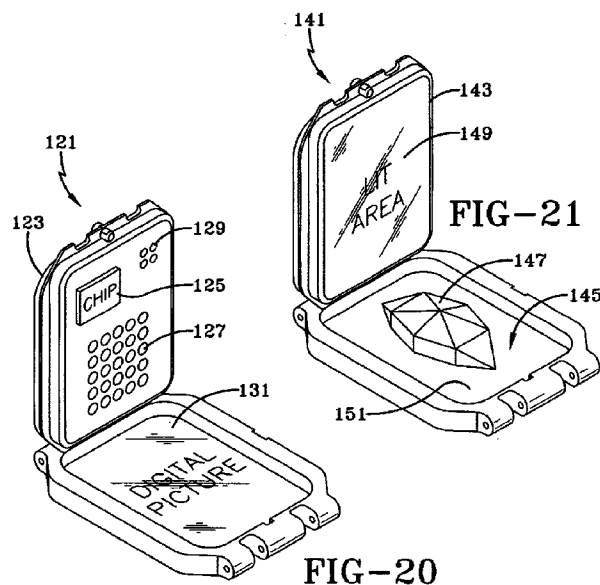


Fig. 6

Claim 24 of the present invention typically recites "a cover (4) that is screwed or clamped into a middle (7) and that defines an external surface of the back;" "a false back (11) installed against an internal surface of said cover;" and "an electronic identification element (5, 6) provided provided only with an integrated circuit and an antenna is installed between said cover (4) and said false back (11)."

ELLNER et al. pertain to a watch. Figures 20 and 21 of ELLNER et al. are reproduced below.



At paragraph 3 the Official Action refers to Figure 22 of ELLNER et al., which is reproduced below.

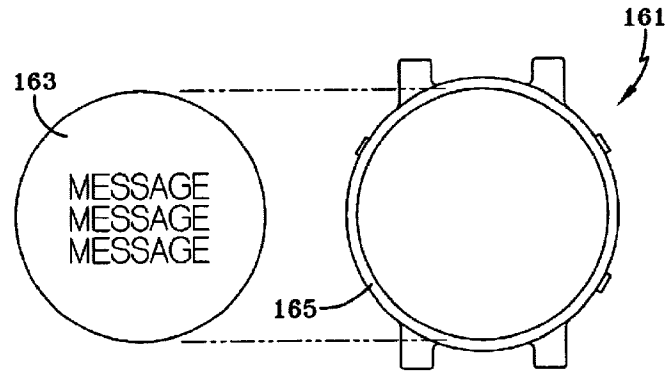


FIG-22

In ELLNER et al., the backing has a functional member located in a secret compartment beneath the timepiece when the latter is in a closed condition.

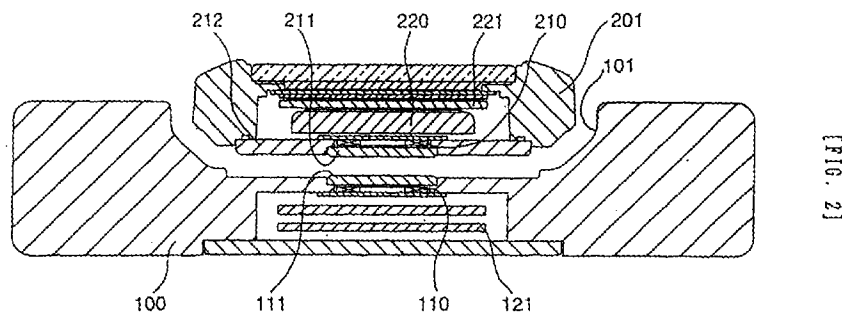
In the present invention the identification element is hermetically sealed in a cavity between the false-bottom and the cover (backing) and is completely independent of the timepiece. Claim 26 of the present invention sets forth: "said false back (11) is attached securely against said internal surface of said cover (4)."

At paragraph 3 the Official Action states: "Element 147 is described at col. 6, lines 60-62 as a functional member that 'can emit signals (electronic, audio, visual, etc.) to indicate the whereabouts of the watch assembly or of the wearer of the watch assembly etc.'."

In the present invention, the identification element includes only two components: an electronic circuit (5) with an internal memory zone and an antenna. It is a passive element without battery. So it cannot emit any signal by itself. Only a special external read/write device can access the data stored in its memory by inductive coupling.

The Official Action refers to HAYAKAWA for teachings pertaining to an antenna.

HAYAKAWA pertains to electronic device in which electrical power transfer and data transfer are performed by exchanging physical energy between a station and an electronic watch. Figure 2 of HAYAKAWA is reproduced below.



HAYAKAWA teaches an inductor 210 (antenna) placed at the back cover of a watch for receiving and transmitting signals to an external device inductor 110. The Official Action asserts that it would be obvious for one skilled in the art to provide an antenna in the device of ELLNER et al. as a necessary component for

receiving/transmitting the identification signals suggested and as taught by HAYAKAWA.

However, in the present invention the identification element has no battery and is embedded between the false back and the cover in metal.

In contrast, the system of HAYAKAWA needs to charge a secondary battery 220. Further as taught by Hayakawa (column 5 line 10): charging is provided via a cover glass in a bottom back cover 212 of the electronic watch main part 201.

At paragraph 6 the Official Action asserts that the provision of a decoration on either side of false back 149 would be obvious for one skilled in the art as a means for accommodating additional elements there on, and as shown in Figures 20-21 of ELLNER et al. for the bottom side of back.

In the present invention, the decoration is only for esthetic reasons. Page 3, lines 15 and 16 of the specification states: "This identification element can be completely hidden between the cover and the false back." Claim 25 of the present invention recites: "the decoration is a surface treatment of the false back (11) identical to that used for other parts of the cover (4) so as to make the utilization of the false back have as little visibility as possible."

At paragraph 8 the Official Action asserts: "one skilled in the art would consider appropriate thickness of the cover 163, if made of metal, such as to permit reception of induction signals

from the exterior and provide sufficient protection as a cover. The selection of the claimed thickness for the cover does not produce any unexpected and such dimension would therefore obvious to one skilled in the art."

However, it is well known that it is very difficult to transmit magnetic fields through a metal layer. For that reason, ELLNER et al. has not mentioned the case, and the cover material and HAYAKAWA has taught (column 5, line 10) that charging is provided via a cover glass in a bottom back cover 212 of the electronic watch main part 201.

It is thus not obvious to select the appropriate thickness of the metal cover 163, such as to permit reception of induction signals from the exterior and provide sufficient protection as a cover because as related at page 7, lines 16-18 of the specification: "the circuit 5 preferably uses a frequency considerably lower than that usually used for standard RFID elements, preferably a frequency lower than 50KHz, in order to enable transmission through the metal." See claims 27 and 28.

In summary, the present invention is different from ELLNER et al.'s in several points:

- the identification element of the present invention is passive and has no battery and no connection to any battery. It is only composed of an integrated circuit and an antenna. In ELLNER et al.'s case, the device must be active and use the battery of

the watch as energy source to perform its function of signal emission.

- The identification element of the present invention is not in a secret compartment as in ELLNER et al. It is only embedded and sealed between the cover and the false-bottom. The identification operation could be done without opening the watch.

- In the present invention, the decoration is only for esthetic reason. The decoration consists of a surface treatment of the false-bottom preferably identical to that used for the other parts of the bottom so as to make the use of a false-bottom as little visible as possible.

The present invention could thus not be obtained by combining the teachings of ELLNER et al. with HAYAKAWA for the following reasons:

- HAYAKAWA's charging system needs a secondary battery for supplying energy to the identification device.

- HAYAKAWA's charging system transfers the energy via a cover glass in a bottom back cover of the electronic watch main part. It is not efficient in our case where the cover is completely in metal.

SATO fails to address the above described deficiencies of the applied art.

One of ordinary skill and creativity would fail to produce a claimed embodiment of the present invention from a

knowledge of ELLNER et al., HAYAKAWA and SATO. A *prima facie* case of unpatentability has thus not been made.

These rejections are believed to be overcome, and withdrawal thereof is respectfully requested.

Conclusion

Prior art cited but not utilized is believed to be non-pertinent to the instant claims.

The objections and rejections are believed to have been overcome, obviated or rendered moot, and that no issues remain. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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